

**OFFICIAL**

Paul, Hastings, Janofsky & Walker LLP  
3579 Valley Centre Drive, San Diego, CA 92130  
telephone 858-720-2500 / facsimile 858-720-2555 / [www.paulhastings.com](http://www.paulhastings.com)

**PaulHastings****FACSIMILE TRANSMISSION****RECEIVED  
CENTRAL FAX CENTER**

APR 21 2004

| <b>from:</b>        | <b>facsimile:</b> | <b>telephone:</b> | <b>initials:</b> |
|---------------------|-------------------|-------------------|------------------|
| Richard H. Pagliery | (858) 720-2555    | (858) 720-2955    | RHP2             |

|  |   |
|--|---|
| <b>client name:</b> Ligand Pharmaceuticals | <b>client matter number:</b> 45026.00065. |
| <b>date:</b> April 19, 2004                | <b>pages (with cover):</b> 16             |
|  | CON1                                      |

| <b>to:</b>                       | <b>company/office:</b>  | <b>facsimile:</b> | <b>telephone:</b> |
|----------------------------------|-------------------------|-------------------|-------------------|
| U.S. Patent and Trademark Office | Centralized Tech Center | (703) 872-9306    |                   |

**In re the Application of:** )  
    **Applicant:** Bochm, et al. )  
    **Serial No.:** 08/479,920 )  
    **Filed:** June 7, 1995 )  
  
**For:** **COMPOUNDS HAVING** )  
    **SELECTIVE ACTIVITY FOR** )  
    **RETINOID X RECEPTORS, AND** )  
    **MEANS FOR MODULATION OF** )  
    **PROCESSES MEDIATED BY** )  
    **RETINOID X RECEPTORS** )

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT**  
**UNDER 37 C.F.R. § 1.181**

If you do not receive all pages, please call immediately Facsimile Center:

*This message is intended only for the use of the individual or entity to which it is addressed, and may contain information that is privileged, confidential and exempt from disclosure under applicable law. If the reader of this message is not the intended recipient, or the employee or agent responsible for delivering the message to the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please notify us immediately by telephone, and return the original message to us at the above address via the U.S. Postal Service. Thank you.*

45026.65 CON

**DOCKETED**

JAN 20 2004

**Paul Hastings**

---

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT  
UNDER 37 C.F.R. § 1.181**

Please acknowledge receipt of the following by affixing hereon the Patent and Trademark Office date stamp and returning this card to our office.

Applicant(s): Boehm, et. al.  
Client: Ligand Pharmaceuticals Inc.  
Serial No.: 08/479,920 Filed: June 7, 1995  
Attorney: Jane K. Babin



**COMPOUNDS HAVING SELECTIVE ACTIVITY FOR RETINOID X RECEPTORS,  
AND MEANS FOR MODULATION OF PROCESSES MEDIATED BY RETINOID X  
RECEPTORS**

Docket No.: 45026.00065.CON1

Date of Deposit: January 6, 2004

Enclosure(s): Transmittal Form (PTO/SB/21 - 1 pg.); Fee Transmittal (PTO/SB/17 - 1 pg.); Petition to Withdraw Holding of Abandonment Under 37 C.F.R. § 1.181 (1 pg.); copy of Petition Pursuant to 37 CFR § 1.313(a) to Withdraw Application from Issuance (3 pgs.); copy of Amendment and Remarks (2 pgs.); and copy of Interview Summary Record (1 pg.)

**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

14

|                      |                 |
|----------------------|-----------------|
| Application Number   | 08/479,920      |
| Filing Date          | June 7, 1995    |
| First Named Inventor | Marcus F. Boehm |
| Group Art Unit       | 1621            |
| Examiner Name        | Paul J. Killos  |

Attorney Docket Number

45026.00065.CON1

**ENCLOSURES (check all that apply)**

|  |   |  |
|--|---|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form                     | <input type="checkbox"/> Drawing(s)                                       | <input type="checkbox"/> After Allowance Communication to Group  |
| <input type="checkbox"/> Fee Attached  | <input type="checkbox"/> Licensing-related Papers                         | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences  |
| <input type="checkbox"/> Amendment/Reply                                     | <input checked="" type="checkbox"/> Petition                              | <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)   |
| <input type="checkbox"/> After Final   | <input type="checkbox"/> Petition to Convert to a Provisional Application | <input type="checkbox"/> Proprietary Information   |
| <input type="checkbox"/> Affidavits/declaration(s)                           | <input type="checkbox"/> Power of Attorney, Revocation                    | <input type="checkbox"/> Status Letter   |
| <input type="checkbox"/> Extension of Time Request                           | <input type="checkbox"/> Change of Correspondence Address                 | <input type="checkbox"/> Other Enclosure(s) (please identify below):   |
| <input type="checkbox"/> Express Abandonment Request                         | <input type="checkbox"/> Terminal Disclaimer                              | Petition to Withdraw Holding of Abandonment Under 37 C.F.R. § 1.181 dated 1/6/04; copy of Petition Pursuant to 37 CFR § 1.313(a) to Withdraw Application from Issuance dated 10/14/98; copy of Examiner Interview Summary Record; and copy of Amendment and Remarks dated 8/10/99. |
| <input type="checkbox"/> Information Disclosure Statement                    | <input type="checkbox"/> Request for Refund                               |  |
| <input type="checkbox"/> Certified Copy of Priority Document(s)              | <input type="checkbox"/> CD, Number of CD(s) _____                        |  |
| <input type="checkbox"/> Response to Missing Parts/ Incomplete Application   |   |  |
| <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 |   |  |
|  | Remarks   |  |

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

36183

PATENT TRADEMARK OFFICE

|                         |  |
|-------------------------|--|
| Firm or Individual name | Paul, Hastings, Janofsky & Walker LLP      |
| Signature               | Jane K. Babin, Ph.D., Esq. Reg. No. 47,224 |
| Date                    | January 6, 2004                            |

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

|                       |              |      |                 |
|-----------------------|--------------|------|-----------------|
| Typed or printed name | Janice Crisp |      |                 |
| Signature             | Janice Crisp | Date | January 6, 2004 |

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# FEE TRANSMITTAL

## for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 130.00)

## METHOD OF PAYMENT (check all that apply)

 Check  Credit card  Money Order  Other  None
 Deposit Account:

Deposit Account Number 50-2613  
 Deposit Account Name

The Director is authorized to: (check all that apply)  
 Charge fee(s) indicated below  Credit any overpayments  
 Charge any additional fee(s) or any underpayment of fee(s)  
 Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

## 1. BASIC FILING FEE

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description        | Fee Paid |
|----------------------------|----------------------------|------------------------|----------|
| 1001 770                   | 2001 385                   | Utility filing fee     |          |
| 1002 340                   | 2002 170                   | Design filing fee      |          |
| 1003 530                   | 2003 265                   | Plant filing fee       |          |
| 1004 770                   | 2004 385                   | Raissance filing fee   |          |
| 1005 160                   | 2005 80                    | Provisional filing fee |          |
| SUBTOTAL (1) (\$ 0)        |                            |                        |          |

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

| Total Claims | Independent Claims | Multiple Dependent | Extra Claims | Fee from below | Fee Paid |
|--------------|--------------------|--------------------|--------------|----------------|----------|
|              |                    |                    | -20** =      |                |          |
|              |                    |                    | -3** =       |                |          |
|              |                    |                    |              |                |          |

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description  | Fee Paid |
|----------------------------|----------------------------|--|----------|
| 1202 18                    | 2202 9                     | Claims in excess of 20                                       |          |
| 1201 86                    | 2201 43                    | Independent claims in excess of 3                            |          |
| 1203 290                   | 2203 145                   | Multiple dependent claim, if not paid                        |          |
| 1204 86                    | 2204 43                    | ** Raissance independent claims over original patent         |          |
| 1205 18                    | 2205 9                     | ** Raissance claims in excess of 20 and over original patent |          |
| SUBTOTAL (2) (\$ 0)        |                            |  |          |

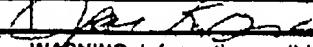
\*For number previously paid, if greater. For Reissues, see above

| Complete If Known    |                  |
|----------------------|------------------|
| Application Number   | 08/479,920       |
| Filing Date          | June 7, 1995     |
| First Named Inventor | Marcus F. Boehm  |
| Examiner Name        | Paul J. Killos   |
| Art Unit             | 1621             |
| Attorney Docket No.  | 45026.00065.CON1 |

## FEE CALCULATION (continued)

## 3. ADDITIONAL FEES

| Large Entity Fee Code (\$)        | Small Entity Fee Code (\$) | Fee Description  | Fee Paid |
|-----------------------------------|----------------------------|--|----------|
| 1051 130                          | 2051 65                    | Surcharge - late filing fee or oath  |          |
| 1052 50                           | 2052 25                    | Surcharge - late provisional filing fee or cover sheet                     |          |
| 1053 130                          | 1053 130                   | Non-English specification  |          |
| 1812 2,520                        | 1812 2,520                 | For filing a request for ex parte reexamination                            |          |
| 1804 920*                         | 1804 920*                  | Requesting publication of SIR prior to Examiner action                     |          |
| 1805 1,840*                       | 1805 1,840*                | Requesting publication of SIR after Examiner action                        |          |
| 1251 110                          | 2251 55                    | Extension for reply within first month                                     |          |
| 1252 420                          | 2252 210                   | Extension for reply within second month                                    |          |
| 1253 850                          | 2253 475                   | Extension for reply within third month                                     |          |
| 1254 1,480                        | 2254 740                   | Extension for reply within fourth month                                    |          |
| 1255 2,010                        | 2255 1,005                 | Extension for reply within fifth month                                     |          |
| 1401 330                          | 2401 165                   | Notice of Appeal   |          |
| 1402 330                          | 2402 165                   | Filing a brief in support of an appeal                                     |          |
| 1403 290                          | 2403 145                   | Request for oral hearing   |          |
| 1451 1,510                        | 1451 1,510                 | Petition to Institute a public use proceeding                              |          |
| 1452 110                          | 2452 55                    | Petition to revive - unavoidable   |          |
| 1453 1,330                        | 2453 665                   | Petition to revive - unintentional   |          |
| 1501 1,330                        | 2501 665                   | Utility issue fee (or reissue)   |          |
| 1502 480                          | 2502 240                   | Design issue fee   |          |
| 1503 640                          | 2503 320                   | Plant issue fee  |          |
| 1460 130                          | 1460 130                   | Petitions to the Commissioner  | 130.00   |
| 1807 50                           | 1807 50                    | Processing fee under 37 CFR 1.17(q)  |          |
| 1806 180                          | 1806 180                   | Submission of Information Disclosure Stmt                                  |          |
| 8021 40                           | 8021 40                    | Recording each patent assignment per property (times number of properties) |          |
| 1809 770                          | 2809 385                   | Filing a submission after final rejection (37 CFR 1.129(a))                |          |
| 1810 770                          | 2810 385                   | For each additional invention to be examined (37 CFR 1.129(b))             |          |
| 1801 770                          | 2801 385                   | Request for Continued Examination (RCE)                                    |          |
| 1802 900                          | 1802 900                   | Request for expedited examination of a design application                  |          |
| Other fee (specify)               |                            |  |          |
| *Reduced by Basic Filing Fee Paid |                            |  |          |
| SUBTOTAL (3) (\$ 130.00)          |                            |  |          |

| SUBMITTED BY      |   | (Complete if applicable)          |                               |
|-------------------|---|-----------------------------------|-------------------------------|
| Name (Print/Type) | Jane K. Babin, Ph.D., Esq.  | Registration No. (Attorney/Agent) | 47,224 Telephone 858-720-2677 |
| Signature         |  | Date                              | 1-6-04                        |

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete. Including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Patent  
45026.00065.CON1  
(formerly 015110.0065.CON1)

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICIAL

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CENTRAL FAX CENTER

APR 21 2004

In re the Application of: ) Group Art Unit: 1621  
Applicant: Boehm, et al. ) Examiner: Killos, Paul J.  
Serial No.: 08/479,920 )  
Filed: June 7, 1995 )  
For: COMPOUNDS HAVING )  
SELECTIVE ACTIVITY FOR )  
RETINOID X RECEPTORS, AND )  
MEANS FOR MODULATION OF )  
PROCESSES MEDIATED BY )  
RETINOID X RECEPTORS )

PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 C.F.R. § 1.181

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby petition under 37 C.F.R. § 181 to withdraw the holding of abandonment.

Applicants respectfully submit that the holding of abandonment is in error.

---

CERTIFICATE OF MAILING  
(37 C.F.R. § 1.8e)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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1-6-04  
Date of Deposit

SAN/72082.3

Junice Crisp  
Name of Person Mailing Paper

*Junice Crisp*  
Signature of Person Mailing Paper

Patent  
45026.00065.CON1  
(formerly 015110.0065.CON1)

A Notice of Abandonment for this case was mailed on May 6, 1999. In an interview on August 10, 1999, the Examiner recognized that the Notice of Abandonment had been issued in error and agreed to revive the case. That agreement is evidenced in the Interview Summary Record. As is discussed below, it appears that that Interview Summary Record was misplaced within the Patent Office file. Whatever the reason, the Patent Office failed to revive the application, as it had agreed to do in the interview. Since the time of the interview, no event has occurred to provide a basis for holding the application abandoned and no additional Notice of Abandonment has been received by the Applicants. Thus, the holding of abandonment should be withdrawn and the application should be held as pending. Moreover, an Amendment filed August 10, 1999, the same day as the interview, placed the Application in condition for allowance. Thus, Applicants respectfully request that the Application be allowed.

Background

On July 28, 1998, Applicants received a Notice of Allowability allowing claims 33-37 and 39-48. Payment of a \$1320.00 issue fee was due on October 28, 1998. On October 14, 1998, Applicants filed a Petition Pursuant to 37 C.F.R. § 1.313(a) to Withdraw Application From Issuance, along with the appropriate petition fee of \$130.00 (copy enclosed). Applicants noted in that Petition that the "claims of the application contain interfering subject matter with the claims of issued U.S. Patent No. 5,466,861 . . ." and further noted that a request for interference would be filed separately. That October 14, 1998 filing was adequate to withdraw the case from issuance as potential

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45026.00065.CON1  
(formerly 015110.0065.CON1)

interference provides "good and sufficient reasons why withdrawal of the application from issue is necessary." See 37 C.F.R. § 1.313(a).

Inspection of the Patent Office file history of the Application (obtained through a third-party service, DigiPat, Arlington VA) showed that Applicants' Rule 313(a) Petition was not in the file and was not recorded in the application "Contents." Notwithstanding Applicants' request for withdrawal from issuance, the application was mistakenly abandoned by the U.S. Patent Office, as evidenced by the "Notice of Abandonment" mailed on May 6, 1999. According to the notice, the application was considered abandoned for failure to pay the issue fee.

Upon receipt of the Notice of Abandonment, Applicants promptly contacted Examiner Killos and confirmed that the abandonment was issued in error. Examiner Killos agreed to correct the mistake and act on the application. On August 10, 1999, Applicants conducted an in-person interview with Examiner Killos, which is memorialized in the Examiner Interview Summary Record (copy enclosed). That Interview Summary Record confirms that the application should not have been abandoned. *See id.* (providing Examiner's comments: "Case to be revived.").

Applicants note that this Interview Summary Record appears to have been misfiled by the Patent Office, which may account for the lack of follow-up. When Applicants obtained a copy of the file history, the Interview Summary Record was notably absent from the Contents listing. Upon careful examination of the file, however, the August 10, 1999 Interview Summary Record was found between an Interview Summary Record dated January 8, 1997 (paper No. 10) and an Office Action dated February 24, 1997 (paper No. 11). Perhaps that misfiling of the August 10, 1999 Interview

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(formerly 015110.0065.CON1)

Summary Record, along with the failure to assign a Paper Number or to catalog the document in the Application Contents, contributed to the inadvertent failure of the Patent Office to recognize that abandonment had been withdrawn.

Also on August 10, 1999, the same day as the interview, Applicants filed an Amendment (copy enclosed). In that Amendment, Applicants cancelled claims containing subject matter that potentially interfered with U.S. Patent Nos. 5,466,861 and 5,837,725 to Dawson, *et al.* The remaining claims, having received a thorough examination on the merits, were thus placed in condition for allowance and a notice to that effect was anticipated by the Applicants.

Applicants thereafter filed a Revocation and Grant of Power of Attorney on July 9, 2001. Then, having not received any correspondence from the Patent Office following the August 10, 1999 Interview and Amendment, Applicants filed a Status Inquiry on November 26, 2001. The Patent Office did not respond to that Status Inquiry. Applicants filed another Revocation and Grant of Power of Attorney on November 1, 2002 and, having not received a response to the Status Inquiry filed November 26, 2001, Applicants inquired as to the status of the application using the Patent Application Information Retrieval (PAIR) system.

Applicants were surprised to learn that as of July 24, 2003, according to the PAIR system, the last four entries in the file history, were:

- (1) Item Number 27 - Mail Notice of Allowance, July 28, 1998;
- (2) Item Number 28 - Abandonment for Failure to Pay Issue Fee, May 6, 1999;

Patent  
45026.00065.CON1  
(formerly 015110.0065.CON1)

(3) Item Number 29 - Mail Notice of Abandonment from Publications, May 6, 1999;  
and

(4) Item Number 30 - Correspondence Address Change, November 25, 2000.

Thus, the PAIR system and File History for the application do not reflect a number of documents filed by Applicants and/or recorded by the Examiner in this case. Specifically:

(1) the Examiner Interview Summary Record dated August 10, 1999, was found in the Patent Office file, but not in the expected location and not indexed in either the file history contents or the PAIR system;

(2) the Amendment filed by the Applicants on August 10, 1999, is absent from Patent Office records; and

(3) the Petition Pursuant to 37 C.F.R. § 1.313(a) to Withdraw Application From Issuance, filed on October 14, 1998, is neither present in the file history nor indexed in either the file history contents or PAIR system records.

#### Conclusion

Applicants respectfully submit that Patent Office error in misplacing or misfiling the documents listed above mistakenly resulted in failure to withdraw the holding of abandonment.

Further, Applicants respectfully submit that the two documents dated August 10, 1999 (*i.e.*, item (1) the Examiner Interview Summary Record, and (2) the Amendment) demonstrate that the Patent Office acknowledged that the application was mistakenly deemed abandoned and agreed to withdraw the holding of abandonment. Since August 10, 1999, no event has occurred that provides a statutory basis for abandonment. Moreover, Applicants have not received a Notice of

Patent  
45026.00065.CON1  
(formerly 015110.0065.CON1)

Abandonment other than the original Notice mailed May 6, 1999, which the Examiner agreed to withdraw.

Accordingly, Applicants hereby petition under 37 C.F.R. § 1.181 to withdraw the holding of abandonment. Applicant provides the required petition fee of \$130.00 under 37 C.F.R. § 1.17(h). If any additional fee is due, the Commissioner is hereby authorized to charge any fee required by this submission to our Deposit Account No. 50-2613.

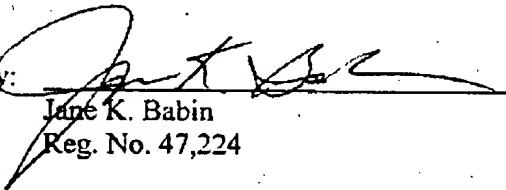
Respectfully submitted,

PAUL HASTINGS JANOFSKY & WALKER LLP

Dated:

January 6, 2007

By:

  
Jane K. Babin  
Reg. No. 47,224

PAUL HASTINGS JANOFSKY & WALKER LLP  
12390 El Camino Real  
San Diego, CA 92130  
Phone: (858) 720-2500  
Fax: (858) 720-2555

PATENT  
214/226

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
BOEHM et al. )  
Serial No.: 08/479,920 ) Art Unit: 1621  
Filed: June 7, 1995 ) Examiner: Killos, P.  
For: COMPOUNDS HAVING SELECTIVE )  
ACTIVITY FOR RETINOID X )  
RECEPTORS, AND MEANS FOR )  
MODULATION OF PROCESSES )  
MEDIATED BY RETINOID X )  
RECEPTORS )

PETITION PURSUANT TO 37 CFR § 1.313(a)  
TO WITHDRAW APPLICATION FROM ISSUANCE

Box Issue Fee  
c/o Technology Center 3700  
U.S. Patent and Trademark Office  
Washington, D.C. 20231

Sir:

Pursuant to 37 CFR § 1.313(a), applicants of the above-identified patent application hereby petition and request withdrawal from issuance of the application, for which applicants have received a Notice of Allowance and Issue Fee Due dated July 28, 1998.

LA-54680.1

CERTIFICATE OF MAILING  
(37 C.F.R. §1.10)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as 'Express Mail Post Office To Addressee' in an envelope addressed to the Box Issue Fee, c/o Technology Center 3700, U.S. Patent and Trademark Office, Washington, D.C. 20231.

EM351173167US  
Express Mail Label No.

Rick Moreno  
Name of Person Mailing Paper

October 14, 1998

*Rick Moreno*

PATENT  
214/226

The reason why withdrawal of the application is necessary is so that an interference can be declared, since the claims of this application contain interfering subject matter with the claims of issued U.S. Patent No. 5,466,861 (Dawson et al.). Specifically, e.g., claim 48 of this application corresponds nearly identically to claim 13 of Dawson et al., U.S. Patent No. 5,466,861.

A Request For Interference will be filed separately by applicants.

Accompanying this petition is our check for \$130.00 for the fee set forth in 37 CFR § 1.17(i). The Assistant Commissioner is hereby authorized to charge any additional fees which may be required by this petition, or credit any overpayment, to Deposit Account No. 12-2475.

Respectfully submitted,

Dated: October 14, 1998  
By:   
Hope E. McVille  
Reg. No. 34,874

LYON & LYON LLP  
633 West Fifth Street  
Suite 4700  
Los Angeles, California 90071-2066  
(213) 489-1600

LA-54630.1

Please acknowledge receipt of the following by affixing hereon the Patent and Trademark Office date stamp and returning this card to our office.

Applicant: BOEHM et al.  
 Serial No.: 08/479,920  
 For: COMPOUNDS HAVING SELECTIVE ACTIVITY FOR RETINOID X RECEPTORS, AND MEANS FOR MODULATION OF PROCESSES MEDIATED BY RETINOID X RECEPTORS  
 Filed: June 7, 1995

Title of Document: PETITION PURSUANT TO 37 CFR § 1.313(a) TO WITHDRAW APPLICATION FROM ISSUANCE

Attorney(s): Hope E. Melville  
 Docket No.: 214/226

Enclosure: Check No. 45089 - \$130.00 (petition filing fee)  
 Express Mail Label No. EM351173167US Date of Deposit: Oct. 14, 1998

UNION BANK OF CALIFORNIA  
 LOS ANGELES, CA 90071

16-49  
 1220

**LYON & LYON LLP**

633 WEST FIFTH STREET, SUITE 4700

LOS ANGELES CALIFORNIA 90071-2066

No. 45089

ATTORNEYS - AT - LAW

DOCKET NO. 214/226

SERIAL NO. 08/479,920

APPLICANT: BOEHM ET AL.

PAY:

TO THE  
ORDER  
OF:

COMMISSIONER OF PATENTS AND TRADEMARKS

| EXPLANATION  | AMOUNT |
|--------------|--------|
| PETITION FEE | 130.   |

DATE OCTOBER 13, 1998 \$ 130.00

LYON & LYON LLP

Pearl - PBM

LYON & LYON  
LOS ANGELES, CALIFORNIA

TO COST OF

PETITION FEE 130.00 (12000)

REMITTANCE ADVICE  
 PLEASE DETACH BEFORE  
 DEPOSITING CHECK

ITEM: RE: BOEHM ET AL  
 DOCKET NO: 214/226  
 NO: 08/479,920

Patent No.  
214/226

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: )  
BOEHM, et al. ) Group Art Unit: 1621  
Serial No.: 08/479,920 ) Examiner: Killos, P.  
Filed: June 7, 1995 )  
For: COMPOUNDS HAVING SELECTIVE )  
ACTIVITY FOR RETINOID X RECEPTORS, )  
AND MEANS FOR MODULATION OF )  
PROCESSES MEDIATED BY RETINOID X )  
RECEPTORS )

---

AMENDMENT AND REMARKS

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Please amend the above-identified application as follows:

IN THE CLAIMS:

Please cancel claims 45, 46 and 48 without prejudice. Pursuant to the discussion  
with Examiner Killos at the Examiner's Interview of even date, Applicant will provide a

---

CERTIFICATE OF FILING  
(37 C.F.R. § 1.6(c))

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being hand delivered to  
United States Patent and Trademark Office, Group 1621 at Crystal Mall I, Arlington, Virginia.

Michael Wise

Name of Person Filing Paper

August 10, 1999  
Date of Deposit

Michael J. Wise  
Signature of Person Filing Paper

Patent No.  
214/226

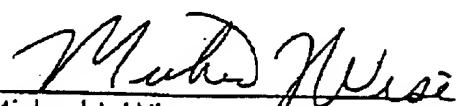
further response and/or amendment that addresses the Examiner's comments regarding  
Davies' U.S Patent No. 5,399,586.

Respectfully submitted,

LYON & LYON LLP

Dated: August 10, 1999

By

  
Michael J. Wise  
Registration No. 34,047

633 West Fifth Street, Suite 4700  
Los Angeles, California 90071-2066  
(213) 489-1600



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|               |             |                       |                      |
|---------------|-------------|-----------------------|----------------------|
| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKETT NO. |
| 08/479920     | 06/07/95    | BOEHM et al           | 214/226              |
|               |             | EXAMINER              |                      |
|               |             | Killas, Paul J        |                      |
|               |             | ART UNIT              | PAPER NUMBER         |
|               |             | 1621                  |                      |

DATE MAILED:

## EXAMINER INTERVIEW SUMMARY RECORD

All participants (applicant, applicant's representative, PTO personnel):

(1) Michael Wier (3) L Elmer  
 (2) C Cardillo (4) \_\_\_\_\_

Date of interview 10 Aug - 1989Type:  Telephonic  Personal (copy is given to  applicant  applicant's representative).Exhibit shown or demonstration conducted:  Yes  No. If yes, brief description: \_\_\_\_\_Agreement:  was reached with respect to some or all of the claims in question.  was not reached.

Claims discussed: \_\_\_\_\_

Identification of prior art discussed: \_\_\_\_\_

Description of the general nature of what was agreed to if an agreement was reached, or any other comments: Case to be  
revised will come in with claims to envelope an  
interference with Davies or second claim & be  
allowed

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

1. It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph below has been checked to indicate to the contrary, A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW (e.g., Items 1-7 on the reverse side of this form). If a response to the last Office action has already been filed, then applicant is given one month from this interview date to provide a statement of the substance of the interview.

2. Since the examiner's interview summary above (including any attachments) reflects a complete response to each of the objections, rejections and requirements that may be present in the last Office action, and since the claims are now allowable, this completed form is considered to fulfill the response requirements of the last Office action. Applicant is not relieved from providing a separate record of the substance of the interview unless box 1 above is also checked.